

Remarks

Claims 9-16 are pending in this application. The Examiner rejected claims 9-13 under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner rejected claims 9-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,679,940 to Templeton *et al.* (Templeton). Applicants respectfully disagree with the Examiner's rejections and request reconsideration in view of the following arguments.

The 35 U.S.C. § 101 Rejections

The Examiner rejected claims 9-13 as directed to non-statutory subject matter. The Examiner's ultimate test for statutory subject matter appears on page 3 as follows:

Applicant's claim language may be executed in ones mind and/or with pen and pencil. As is, the claims in question are abstract in nature and don't produce a useful, concrete, and tangible result.

Without agreeing that the Examiner has stated the correct test for patentable subject matter, independent claims 9 and 12 meets the requirements laid out by the Examiner.

Independent claim 9 provides a method for determining the collectability of check writers. The method includes storing a negative *file* in a *database*, the negative file including negative information about each of a plurality of check writers. Storing a *file* in a *database* cannot be done with a pen or pencil. Nor can anyone known to the undersigned manipulate a *file* in a *database* telepathically. Claim 9 also provides for modifying the negative file by removing the negative information for each check writer classified within a pre-determined set of the categories and retaining the negative information for each check writer not classified within the pre-determined set of categories. Modifying the negative file produces a *modified negative file*, certainly "a useful, concrete and tangible result" as this phrase is used by the courts.

Independent claim 12 provides a method for determining the collectability of a check writer including receiving negative information about the check writer from a database and *removing the negative information from the database* if a category into which the check writer is classified is one of a pre-determined set of categories. A database cannot be accessed with a pen, pencil, or one's mind. Further, removing negative information from the database *changes the database*. The changed database is "a useful, concrete and tangible result."

Under the Examiner's own formulation, both claims 9 and 12 are directed to statutory subject matter. Claims 10, 11 and 13 depend from either claim 9 or claim 12 and therefore also are directed to statutory subject matter.

The 35 U.S.C. § 103 Rejections

The Examiner rejected claims 9-16 as being obvious in view of Templeton. According to M.P.E.P. § 2142, three criteria must be met for the Examiner to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in Templeton or in knowledge generally available to one of ordinary skill in the art, to modify Templeton. Second, there must be a reasonable expectation that this modification will succeed. Finally, Templeton must teach or suggest all claim limitations.

Independent claim 9 provides for classifying each check writer into one of a plurality of categories. Independent claim 12 provides for processing negative information to determine a score and for classifying the check writer within one of a plurality of categories based on the score. Independent claim 14 provides a processor operative to classify individual check writers into one of a plurality of pre-determined categories.

In rejecting claims 9-16, the Examiner has not pointed to any teaching or suggestion in Templeton, or anywhere else, of classifying anything. In fact, the Examiner makes no mention of classification whatsoever. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 9, 12 and 14 are patentable over Templeton. Claims 10, 11, 13, 15 and 16 depend from one of claims 9, 12 or 14 and are therefore also patentable.

Claims 9-16, as pending in this application, meet all substantive requirements for patentability. Applicants therefore request that this case be passed to issuance. No fee is believed due by filing this paper. However, any fee due may be withdrawn from Deposit Account No. 02-3978 as specified in the Application Transmittal.

Respectfully submitted,

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